



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,186	02/26/2002	Akira Kimura	SON-2356	4346

23353 7590 08/02/2007
RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

2137

MAIL DATE	DELIVERY MODE
-----------	---------------

08/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/082,186

Applicant(s)

KIMURA, AKIRA

Examiner

Michael Pyzocha

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 35-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 and 35-46 have been considered.

2. In view of the appeal brief filed on 04/17/2007,

PROSECUTION IS HEREBY REOPENED. New Grounds of rejection are

5 set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office
10 action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal
15 brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of
20 reopening prosecution by signing below.

Claim Rejections - 35 USC § 103

Art Unit: 2137

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not
identically disclosed or described as set forth in section 102 of this
title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole
would have been obvious at the time the invention was made to a person
10 having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the
invention was made.

3. Claims 1-9, 13-21, and 35-42 are rejected under 35 U.S.C.
103(a) as being unpatentable over Kramer (US 6286099) in view of
15 Nemirofsky (US 5880769).

As per claims 1, 13, and 35, Kramer discloses first
identification information storage means for storing a first
identification information for discriminating said terminal,
said first identification information comprising a terminal
20 identifier that uniquely identifies the terminal (see Kramer
Figure 4 numeral 4140, Figure 6 and column 8 lines 56-63);
communication means for communication with said authentication
device wherein said communication including transmitting the
first identification information from the terminal to the
25 authentication device, and receiving encryption key information
from the authentication device in response to transmitting the
first identification information (see Kramer Figure 6 and column

Art Unit: 2137

9 lines 35-48); encrypting means for encrypting the second
identification information input by said operating means based
on said encryption key information received from said
authentication device, wherein said encryption key information
5 is generated by the authentication device in response to
receiving the first identification information from the terminal
(see Figure 6, column 9 lines 35-48 and column 5 lines 53-62).

Kramer fails to teach that the terminal is a portable card
terminal with operating means for inputting a second
10 identification information associated with said first
identification information.

However, Nemirofsky teaches such a portable card terminal
with operating means (see Nemirofsky column 4 line 50 through
column 5 line 15).

15 At the time of the invention it would have been obvious to
a person of ordinary skill in the art for the terminal of Kramer
to be a portable card terminal.

Motivation to do so would have been to allow a user to
access financial information from remote locations using a hand-
20 held portable device (see Nemirofsky column 1 lines 44-50).

As per claims 2-7, 9, 14-19, 21, 36-40, and 42, the
modified Kramer and Nemirofsky system discloses the portable
terminal is issued to said service user by a service provider to

Art Unit: 2137

offer preset services for said service user in a credit sale system, an inter-account instant payment system and E-commerce carried out over a preset network and is in the form of a card (see Nemirofsky column 4 line 50 through column 5 line 15).

5 As per claims 8, 20, and 41, the applicant describes the portable terminal of claim 4 (etc), which is met by the modified Kramer and Nemirofsky system, with the following limitation:

 Wherein said second identification information stored in said transient storage means is erased every preset time
10 interval.

 Nemirofsky in view of Schneier do not appear to disclose erasing the information every preset time interval. Examiner took official notice in a previous action that the idea of erasing information every preset time interval is well-known in
15 the art. Examiner has taken Applicant's lack of rebuttal as an implicit admission that the concept is well-known in the art (See MPEP 2144.03 [R-1]). It would have been obvious to one of ordinary skill in the art at the time the invention was filed to erase information every preset time interval in order to free
20 memory space.

4. Claims 10-12, 22-24, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kramer and

Art Unit: 2137

Nemirofsky system as applied to claims above and further in view of Martino (US 5276314).

As per claims 10-12, 22-24, and 43-46, the modified Kramer and Nemirofsky system discloses first identification information storage means having the first identification information stored
5 therein for discriminating said portable terminal, said first identification information comprising a portable card terminal identifier that uniquely identifies the portable card terminal (see Kramer Figure 4 numeral 4140, Figure 6 and column 8 lines
10 56-63); operating means including display means for displaying letters included in a group of letters and selection means for selecting the letters making up the second identification information from among the letters displayed on said display means, said operating means inputting the second identification
15 information associated with said first identification information (see Nemirofsky column 4 line 50 through column 5 line 15); first communication means for communication with said authentication device, wherein said communication includes transmitting the first identification information to said
20 authentication device and receiving said encryption key information from the authentication device in response to transmitting the first identification information (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); second

Art Unit: 2137

identification information storage means having the first identification information and the second identification information stored therein (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); encryption key generating information generating means for generating said encryption key generating information, wherein said encryption key information is generated in response to receiving the first identification information from said portable terminal (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); second communication means for communication with said portable terminal (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62); comparator authentication means for comparing the second identification information encrypted by said encryption means to said encryption key generating information by way of authentication (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62 and Nemirofsky column 4 line 50 through column 5 line 15); said portable terminal encrypts the second identification information input from said operating means, based on said encryption key generating information received from said authentication device through said first communication means, and the so encrypted second identification information is transmitted through said first communication means to said authentication device, and wherein, in said authentication

Art Unit: 2137

device, the encrypted second identification information received through said second communication means and the second identification information stored by said second identification storage means are compared to each other based on said

5 encryption key generating information by way of performing the authentication (see Kramer Figure 6, column 9 lines 35-48 and column 5 lines 53-62 and Nemirofsky column 4 line 50 through column 5 line 15).

The modified Kramer and Nemirofsky system does not disclose
10 irregularly displaying letters in a group of letters and selection means for selecting the letters making up the second identification information from the letters irregularly displayed.

However, Martino teaches such irregular display of letters
15 (see the Abstract).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to irregularly display the characters to enter the PIN of the modified Kramer and Nemirofsky system.

20 Motivation to do so would have been prevent an observer from determining which symbols are of interest (see Martino Abstract).

Response to Arguments

5. Applicant's arguments with respect to claims 1-24 and 35-46 have been considered but are moot in view of the new ground(s) of rejection.

5

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zeidler, Nakamura, Fernando, Chasko, and Sipman teach methods of exchanging a key as described in the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status
5 information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
10 like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP

15


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER